

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 09/694,191

Customer No.: 22927

Attorney Docket No.: 96-059-C1

Date Filed: October 23, 2000

Title: METHOD AND DEVICE FOR GENERATING A
SINGLE-USE FINANCIAL ACCOUNT NUMBER

Applicants: Walker et al.

Group Art Unit: 3714

Examiner: ELISCA, Pierre E.
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COMMENT ON STATEMENT OF REASONS FOR ALLOWANCE

Mail Stop Issue Fee
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Examiner:

In response to the Reasons for Allowance in the Notice of Allowability mailed July 14, 2010, Applicants respectfully request consideration of the following Comments on those Reasons.

REMARKS

A. INTRODUCTION

Applicants are grateful for the Examiner's acknowledgment of the allowability of Claims 35-42 in the Notice of Allowability mailed July 14, 2010.

Applicants respectfully wish to clarify some statements made by the Examiner in the Reasons for Allowance.

B. STATED REASONS FOR ALLOWANCE

The Reasons for Allowance include the following statements (emphasis added):

2. Regarding the claimed terms, the Examiner notes that a "general term must be understood in the context in which the inventor presents it." *In re Glaug* 283 F.3d 1335, 1340, 62 USPQ2d 1151, 1154 (Fed. Cir. 2002). Therefore the Examiner must interpret the claimed terms as found on pages 1-26 of the specification. Clearly almost all the general terms in the claims may have multiple meanings. So where a claim term "is susceptible to various meanings, ... the inventor's lexicography must prevail" *Id.* Using these definitions for the claims, the claimed invention was not reasonably found in the prior art.

3. The reason for allowance is based on the Board of Appeal's decision.

C. COMMENTS ON STATEMENT OF REASONS FOR ALLOWANCE

Applicants appreciate the acknowledgement in paragraph 3 of the Decision by the Board of Appeals and the Board's findings and analysis explaining why certain subject matter of the allowed claims was not present in the references at issue on appeal.

However, paragraph 2 includes conclusory and regrettably uninformative statements about additional reasons for allowance. The statements allege the presence of unspecified "general terms in the claims" and imply that the Examiner has adopted a new claim construction not presented by the Examiner to the Board on appeal, for all of the allowed claims. The Examiner alleges that it is necessary to limit the scopes of all claims according to unidentified "definitions" and "lexicography" allegedly found somewhere in the entirety (pages 1-26) Applicants' specification. In contrast to the Court's detailed discussion and analysis in Glaug, the Examiner does not identify any particular term of either the claims or the Specification as being a "general term" susceptible of various meanings.

The reasons for allowance do not specify either (i) what specific claimed subject matter is susceptible to “multiple meanings”; (ii) what particular alleged “lexicography” is being applied by the Examiner to define any such specific subject matter; or (iii) what specific “prior art” was overcome by the alleged “definitions for the claims”. Also, the statements do not appear to be reconcilable with the Board’s Decision, which did not refer to any “general terms” or the necessity of resorting to “inventor’s lexicography” in order to distinguish any claim over the cited references on appeal. For at least these reasons, Applicants cannot assess adequately the statement of reasons for allowance in paragraph 2 and must traverse.

Applicants respectfully request that the Examiner reconsider and withdraw the statements made in paragraph 2 of the reasons for allowance.

D. CONCLUSION

If the Examiner has any questions regarding this paper or the present application, the Examiner is cordially requested to contact Michael Downs at telephone number (203) 461-7292 or via electronic mail at mddowns@finchamdowns.com.

Respectfully submitted,

October 14, 2010
Date

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